

REMARKS

This is in response to the Office Action that was mailed on January 17, 2007. Claims 1-3 are cancelled, without prejudice. No new matter is introduced by this Amendment. Claims 4-6 remain pending in the application.

Claims 1-6 were rejected under 35 USC § 103(a) as being unpatentable over “the admission in the background section of the specification of the instant application (page 1 line 14 – page 2 line 8” in view of US 6,521,112 B1 (Balisky), US 5,152,877 (Nishino), and US 2001/0075323 A1 (Graf). The rejection is respectfully traversed with respect to claims 4-6.

Applicant’s previous remarks in this application have pointed out numerous deficiencies in the statement of the rejection, particularly with respect to its reliance upon alleged “admissions”. All of those previous remarks are incorporated herein by reference.

All of the claims herein expressly require the step of “calculating a feed cycle of adding a predetermined amount of said diluting liquid ... wherein ... said feed cycle T for adding the predetermined amount of said diluting liquid is, $T=T_o \times (1+C \times (PV_a-SV_a))+D$.” Applicant’s claims define each of the terms of the equation.

The present remarks focus on the Examiner’s contention in the paragraph bridging pages 5-6 of the Office Action that “The method of the admitted prior art in view of Balisky would inherently include that the current value is I, and A and B are optional constants, a standard cycle T_o for adding said diluting liquid to said electrolytic solution is $T_o=A/I+B$, and wherein said measured salt concentration is PV_a , said objected salt concentration is SV_a , and C and D are optional constants, said feed cycle T for adding the predetermined amount of said diluting liquid is, $T=T_o \times (1+C \times (PV_a-SV_a))+D$ ”. Thus, instead of showing where Balisky or “the admitted prior art” disclose these expressly recited features of Applicant’s invention, the Examiner has merely quoted them from Applicant’s claims and characterized them as “inherent”, without any attempt to provide reasoning in support of his contention.

The statement of the rejection in the Office Action of 01/17/2007 clearly fails to comply with the dictates of MPEP 2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. ... The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the *facts gleaned from the prior art*.

MPEP 2142, emphasis supplied. Where does Balisky or “the admitted prior art” disclose the expressly recited features of Applicant’s invention which the Examiner has characterized as “inherent?”

Also, Applicant respectfully reminds the Examiner that even if a claimed method is within the broad field of the prior art, and even if one might possibly arrive at the claimed method by selecting specific items and conditions from among all possible parameters applicable to the method, this does not render the method obvious in the absence of some directions or reasons for making such selection. Compare *Ex parte Kuhn*, 132 USPQ 359 (POBA 1961).

As noted above, the Examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. Where, as here, the Examiner has failed produce a *prima facie* case, Applicant is under no obligation to submit evidence of nonobviousness. Nevertheless, Applicant points out that the present invention provides the unexpected benefit that concentrations in electrolytic solutions (e.g., of hydrochloric acid and aluminum hydrochloride) can be advantageously controlled, e.g., by an inexpensive programmable controller, without the need for an expensive control device, such as a Physical Interface Device (PID) controller, by utilizing the simple formula recited in the present claims. Specification, page 15, lines 7-12.

Applicant respectfully submits that the rejection as stated by the Examiner depends upon alleged “admissions” which have been expressly controverted by Applicant. Moreover, the Examiner has not demonstrated that either “the admission in the background section of the specification of the instant application (page 1 line 14 – page 2 line 8” or Balisky or Nishino or Graf teaches or suggests the step of “calculating a feed cycle of adding a predetermined amount

of said diluting liquid ... wherein ... said feed cycle T for adding the predetermined amount of said diluting liquid is, $T=T_o \times (1+C \times (PV_a-SV_a))+D$," required by all of the claims currently pending before the Examiner. Also, Applicant has additionally previously pointed out other substantive defects in the rejections of record. Accordingly, it is clear that the Examiner has failed to state a sustainable rejection against any of claims 4-6 herein. Withdrawal of the rejection of record, and passage of this application to Issue, are respectfully solicited.

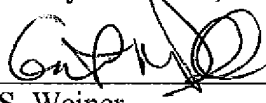
Contact

If there are any questions, the Examiner is invited to contact Richard Gallagher, Registration No. 28,781, at (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: April 17, 2007

Respectfully submitted,

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